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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/775,757

02/09/2004

Duane Allen Ansel

53313/1:2

8726

3528 7590 11/24/2008

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EXAMINER

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ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

11/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/775,757	<b>Applicant(s)</b> ANSEL ET AL.	
	<b>Examiner</b> THUY VI NGUYEN	<b>Art Unit</b> 3689	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-13 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13, 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's communication filed on May/09/08 wherein:

Claims 1-2 have been amended;

Claims 3-30 have been added.

The restriction has been made on July/16/08 wherein Claim 1, 3-30 are in Group I and Claim 2 is in Group II.

**Note:** The Examiner incorrectly stated in the restriction (July/16/08) that dependent claims 14-15 are in Group I; However, they are actually in Group II since they are dependent on the independent claim 2 of Group II. Therefore, these claims will not be examined with the elected Group I.

2. This is in response to the applicant's communication filed on August/18/ 2008, wherein applicant has elected with traverse Group I, claims 1, 3-13, 16-30.

### ***Election/Restrictions***

3. Applicant's election with traverse of method, system, and computer-readable storage medium containing instructions for carrying out a sponsorship exchange in the reply filed on 07/21/08 is acknowledged. The traversal is on the ground(s) that the claim 1 of Group I is generic, the auction recited in non-elected claim 2 of Group II is one method for carrying out a sponsorship exchange. This is not found to be persuasive. As indicated in the previous office actions, Inventions are unrelated if it can

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be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). The claims of Group I include the steps of:

"a) recording..., b) determining..., c) presenting and d) making ..."

which have different modes of operations and producing different effects from the claims of Group II which include the steps of:

"a) defining ..., b) taking ..., c) recognizing ... and d) transmitting ...".

Again, the claims in the groups having different modes of operation (steps) thus producing different effects and are not capable of use together due to different steps. Applicant's comment that claim 1 is generic is not persuasive because applicant appears to discuss about the scope of the preamble between the two group, however, as indicated above, the restriction of the groups are due to the fact that they (the groups) are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). The steps of Group I are not "generic steps" over the steps of Group II as shown above.

Applicant's comment that "the last step of claim 1" could be done in the context of an auction because claim 1 is generic is noted, however, as indicated above, applicant appears to discuss about the scope of the preamble between the two group, however, as indicated above, the restriction of the groups are due to the fact that they (the groups) are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). The steps of Group I are not "generic steps" over the steps of Group II as shown above.

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Although Examiner classified both Groups into 705/1, this alone is not sufficient to prove lack of serious burden. Referring to MPEP § 808.02 an Examiner may establish burden from one of the following: 1) Separate classification thereof, 2) Separate status in the art when they are classifiable together, or 3) a different field of search. Here, Examiner believes there to be a sufficient different field of search due to the difference between Group I which provide a method, system and computer storage medium for carrying out a sponsorship exchange, whereas Group II provides a method for carrying out a sponsorship. Moreover, where the classification is the same and the field of search is the same, there may be adequate burden if there is a clear indication of separate future classification. The present application is classified in business method miscellaneous, which is currently undergoing reclassification and is a very broad classification. Although the application has been classified as 705/1, this is a relatively new class/subclass which is undergoing reclassification.

***Claims Status***

4. Claims 1 (method), 3-13 (method), 16-28 (system), 29-30 (computer readable storage medium) are pending and rejected as followed.

As of 05/09/08, system independent claim 16 is as followed:

Claim 16: A system for carrying out a sponsorship exchange, comprising:

a) an agent server communicatively coupled to a network; and

b) a request database communicatively coupled to the agent server comprising a catalog of a plurality of services and/or tangible, non-monetary assets available to an event owner for putting on an event,

wherein the agent server is to present the catalog to the event owner and to receive a request from the event owner for a service or tangible, non-monetary asset selected from the catalog over the network, wherein the request is associated with a sponsorship offer comprising a sponsorship opportunity to be given to a provider of the requested service or tangible, non-monetary asset at the event and a portion of the cost of the request defrayed by the sponsorship opportunity, and wherein the agent server is to make the request and the associated sponsorship offer available to one or more potential providers of the request over the network.

1. **Note:** that it appears that independent claim 16 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d

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1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. “*for putting on an event, to present the catalog.....potential providers of the request over the network*” carries no patentable weight.

Therefore the claim reads as follow:

A system for carrying out a sponsorship exchange comprising;

a) an agent server communicatively coupled to a network; and

b) a request database communicatively coupled to the agent server comprising a catalog of a plurality of services and or tangible, non-monetary assets available to an even owner

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See

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MPEP § 2172.01. The omitted structural cooperative relationships are between step b *“determining the event owner is interested in trading at least one sponsorship opportunity to at least partially defray a cost of the request”* and step c *“presenting to the event owner a sponsorship offer to be associated with the request”*. What happen if the event owner is not interested in the trading the sponsorship?

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**7. Claims 1, 3-13** are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims **1, 3-13** the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. The process steps of *“recording a request, determining the event owner, presenting to the event owner and making the request...”* is not tied to another statutory



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class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**11.** Claims 1, 3-13, 16-30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MUNSON (US 2002/0091767).

**As for independent claim 1**, MUNSON discloses a method for carrying out a sponsorship exchange, comprising:

a) recording a request for at least one service submitted by an event owner

{see a flow chart on appendix A and B, pages 23-24, discloses the recording a request for a service submitted by a seller or event owner or property owner; see figures 1-8, 24, 37-41; pars. 0024, 0031-0032, 0038, 040-0041; discloses *the property listing events from the property owner or event manager or event owner*}

b) determining the event owner is interested in trading at least one sponsorship opportunity to at least partially defray a cost of the request;

{MUNSON inherently discloses this feature; see figures 1-8, 24, 37-41; pars. 0024, 0031-0032, 0038, 040-0041; discloses *the property listing events of the property owner or sellers who seek for a sponsor for an event*.

Alternatively, as for the feature of determining the user or an entity is interested in trading the sponsorship is common, old and well known in the art for advertising of the sponsor company as well as lowering the cost of hosting an event for the business

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owner. It would have been obvious to one of ordinary skill in the art to use this feature for the benefit as stated above.

c) presenting to the event owner a sponsorship offer

{see at least figures 9-12; par. 0036-0037, notifying/presenting the property owner the sponsorship information e.g. the request for proposal (RFP)

d) making the request and associated sponsorship offer available to one or more potential providers of the requested service.

{see at least figures 13-20; and figures 49-50; pars. 0036- 0037; discloses the sponsorship information is displayed or available to the providers or buyers or sponsors; see appendix page 26, element “show a form to the seller/owner to propose property/sponsorship offer to the buyer/sponsor” }.

**Note:** for convenience, letters (a)-(d) are added to the beginning of each step.

**Note:** in step (a), the phrase “for user in putting on the event” is not a positive recited method step but merely intended use of the recording a request for a service and thus having no patentable weight.

**As for claims 3-4**, which deal with the modification/or changing or customizing the information e.g. sponsorship offer by user, e.g. owner event or sellers. This is fairly taught in MUNSON, pars. 0030-0032, 0039, figures 8, 28. More over, as for the term “capable of being modified by the event owner” is not a positive claimed and carried no patentable weight. See MPEP 2106.01

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**As for claims 5 -6**, which deal with the determining a portion of the cost of the request defrayed by the sponsorship that is given to the provider/buyer at the event, this is fairly taught in MUNSON; see figures 24, 38-40; "*sponsorship price range*".

**As for claim 7**, MUNSON discloses a provider capable of providing the requested service {see abstract, pars. 0024-0026}.

**As for claim 8**, MUNSON discloses transmitting the request and associated sponsorship offer to the identified provider {see at least figures 13-20; and figures 49-50; par. 0037; discloses the sponsorship information is displayed or available to the providers or buyers or sponsors}.

**As for claim 9**, which deals with the receiving an acceptance for the sponsorship offer from the provider or buyer, this is fairly taught in MUNSON, figures 49-50, and claim 14, page 29 " sponsor/or buyer/ or provider accept the sponsorship proposal" .

**As for claims 10-12**, which deal with the receiving a counteroffer/ or proposal to the request and associated sponsorship offer from the identified provider or buyer {see par 0037},

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Alternatively, Official Notice is taken that it's well known in the bargain negotiating process the submitting of counter offer to a request-for-proposal (RFP) for further price negotiation if desired. Therefore, it would have been obvious to modify the teaching of MUNSON to include the step of counter-offer to the RFP for further negotiation if desired.

**As for claim 13**, which deals presenting a catalog of services to the event owner/seller, this is fairly taught in MUNSON {pars. 0043, figures 43-45}

**As for independent claim 16**, A system for carrying out a sponsorship exchange comprising;

a) an agent server communicatively coupled to a network

{See pars 0003, 0024, abstract e.g. the system provide a website "sponsorwise.com" available to users via the Internet}

b) a request database communicatively coupled to the agent server comprising a catalog of a plurality of services and or tangible, non-monetary assets available to an even owner {see pars 0024,0043-0044; at least figures 44-45 " database", categories or list of event /catalog where the users (owner/seller or sponsor/provider/buyer) can get access}.

**As for claim 17**, which deals with server/website, identifies a provider or sponsor provide the requested service, this is fairly taught in MUNSON pars. 0004, and a flowchart on page 26 (appendix)}.

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**As for claim 18**, which deals with the server /website transmits the request/information e.g. sponsorship offer to the provider/or buyer, this is fairly taught in MUNSON pars {see pars. 0036-0037; figures 8-20}.

**As for claim 19**, which deals with the receiving an acceptance of the request/information about sponsorship offer from the provider/buyer this is fairly taught in MUNSON, figures 49-50, and claim 14, page 29 " sponsor/or buyer/ or provider accept the sponsorship proposal" .

**As for claims 20-22**, which deal with the receiving a counteroffer/ or proposal to the request and associated sponsorship offer from the identified provider or buyer {see par 0037}. Alternatively, Official Notice is taken that it's well known in the bargain negotiating process the submitting of counter offer to a request-for-proposal (RFP) for further price negotiation if desired. Therefore, it would have been obvious to modify the teaching of MUNSON to include the step of counter-offer to the RFP for further negotiation if desired.

**As for claims 23-24**, which deal with the modification the counter offer or cost and is provided to the provider/buyer at the event, this is fairly taught in MUNSON {see figures 24, 38-40}.

**As for claims 25-28**, which deals receiving the response, bids/information in according with the cost/prices {see figures 24, 38-40}.

**As for independent claim 29**, MUNSON discloses a computer readable storage medium comprising instructions to cause a computing system to perform a method for

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carrying out a sponsorship exchange to allow an even owner to receive a service from a provider, the method comprising:

a) presenting to the event owner a catalog of services available from one or more providers

{see at least figures 1, 44-45, par 0030, flow chart on page 24 (appendix); discloses the categories of the services}.

b) receiving a request for a service selected from the catalog {see page 23-24, flowchart (appendix); for receiving a service request; see figures 1-8, 24, 37-41};

c) associating a sponsorship opportunity related to the event with the request to defray a portion of a cost of the request;

{see at least figures 9-12pars. 0024, 0031-0032, 0038, 040-0041; discloses *the property listing events from the property owner or event manager or event owner*};

d) transmitting the request and sponsorship opportunity to a provider

{see at least figures 13-20; and figures 49-50; pars. 0036- 0037; discloses the sponsorship information is displayed or available to the providers or buyers or sponsors; see appendix page 26, element “ *show a form to the seller/owner to propose property/sponsorship offer to the buyer/sponsor*”}.

**Note:** in step (a), the phrase “*for user in putting on the event, step (d) ...capable of providing....*” is not a positive recited method step but merely intended use of the presenting a catalog and transmitting the information/request and thus having no patentable weight.

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**As for claim 30**, which deals with the providers/buyer receiving the a plurality of bids/or an price offer, and selecting price offer for the sponsorship request from the owner/sellers, this is fairly taught in MUNSON {see at least figures 24 and 38 pars 0035-0037. flow chart on page 26 (appendix)}.

### ***Conclusion***

**13.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a



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/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689